

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.	:	09/699,402	Confirmation No. :	6990
First Named Inventor	:	Masahiro MATSUO		
Filed	:	October 31, 2000		
TC/A.U.	:	2131		
Examiner	:	A K MOORTHY		
Docket No.	:	038849.49341		
Customer No.	:	23911		
Title	:	Network Apparatus		

PETITION TO WITHDRAW FINALITY UNDER 37 C.F.R. § 1.181

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully submit that the Office Action issued on October 3, 2008, was made final prematurely, and accordingly, the finality of this Office Action should be withdrawn.

Regarding the propriety of final rejections on a second or subsequent action on the merits, M.P.E.P. § 706.07(a) states that such actions:

shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

It is respectfully submitted that the new ground of rejection in the final Office Action issued on October 3, 2008, was not necessitated by Applicants' amendment and was not based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 C.F.R. § 1.97(c). Instead, it is respectfully submitted that the Office Action issued on February 21, 2008, improperly rejected 2 for anticipation.

The non-final Office Action issued on February 21, 2008, included the following rejections:

- Claims 2, 4-6, 8, 10, 12, 16, 18-20 and 22-26 were rejected under 35 U.S.C. § 112, first paragraph as not complying with the written description requirement.
- Claims 2-20 and 24-26 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,867,821 to Ballantyne et al. (“Ballantyne”); and
- Claims 22 and 23 as being obvious under 35 U.S.C. § 103(a) in view of the combination of Ballantyne and U.S. Patent No. 6,266,664 to Russell-Falla et al. (“Russell-Falla”).

The rejection under 35 U.S.C. § 112, first paragraph was due to the claim recitation that the main device includes “a second display operable to display the obtained information.”

A Reply filed on May 9, 2008, among other things, amended claim 2 to replace the claim recitation of the main device including a second display with the claim recitation that “the main device is configured to be connected to a second display operable to display the obtained information.” The Reply argued that Ballantyne did not disclose this claim element.

The Reply also argued that Ballantyne did not disclose the unamended claim element that “the main device determines whether the second display displays the obtained information based on the display switching signal sent from the remote controller device.” In particular, Applicant noted that, with respect to claim 22, the Office Action acknowledges that Ballantyne does not disclose:

determining whether the second display of the main device displays the obtained information based on the display switching signal sent from the remote controller device.

Accordingly, Applicant argued that for similar reasons Ballantyne did not disclose the similar unamended element of claim 2.

The final Office Action rejects claims 2, 4-12, 16, 18-20 and 22-26 for obviousness under 35 U.S.C. § 103(a) in view of the combination of U.S. Patent No. 5,867,821 to Ballantyne et al. (“Ballantyne”) and U.S. Patent No. 6,266,664 to Russell-Falla et al. (“Russell-Falla”).

With respect to Applicant’s claim 2, the final Office Action states that “Ballantyne et al does not teach determining whether the second display of the main device displays the obtained information based on the display switching signal sent from the remote controller device.” The final Office Action relies upon Russell-Falla to remedy this deficiency of Ballantyne.

Because the claim recitation that “the main device determines whether the second display displays the obtained information based on the display switching signal sent from the remote controller device”, was not amended, and it is clear that Ballantyne’s failure to disclose this unamended claim element was the reason why the new grounds of rejection added Russell-Falla, Applicant’s amendments did not necessitate the new grounds of rejection. Instead, the failure of Ballantyne to disclose an unamended claim element is what necessitated the new ground of rejection.

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Because the new ground of rejection in the final Office Action issued on October 3, 2008, is not necessitated by Applicants amendments of the claims and is not based on information cited by the Applicants in an Information Disclosure Statement filed during the period set forth in 37 C.F.R. § 1.97(c), it is respectfully submitted that the finality of this Office Action is improper and should be withdrawn.

It is believed that no fees are due for this petition. However, if fees are required this paper should be considered as an authorization to charge Deposit Account No. 05-1323 (Docket #038849.49341) for such fees.

Respectfully submitted,

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